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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,799	07/25/2001	Noel Enete	06975-133001	4883
26171	7590	08/11/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			GOLD, AVI M	
			ART UNIT	PAPER NUMBER
			2157	
DATE MAILED: 08/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/911,799	ENETE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Avi Gold	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 36-77 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 36-77 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/20/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is responsive to the amendment filed on April 17, 2006. Claims 70-77 were added. Claims 36, 48, 56, 64, 68, and 69 were amended. Claims 36-77 are pending.

### ***Response to Amendment***

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 36-38, 43, 48-51, 56-58, 63-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al., U.S. Patent No. 6,212,548, further in view of Ozkan et al., U.S. Patent No. 6,748,421.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 36, 56, and 68, DeSimone teaches a communications method, comprising:

establishing an instant messaging communications session between a sender and a recipient through an instant messaging host (col. 1, lines 25-33, col. 4, lines 24-29, DeSimone discloses Internet Relay Chat with a protocol); and

during the instant messaging communications session between the sender and the recipient:

generating a video instant message on behalf of the sender (col. 1, lines 45-47, col. 15, lines 58-63, DeSimone discloses video communication through chat and the video sent as an attachment which would be completed by the sender);

storing the video instant message (col. 1, lines 45-47, col. 15, lines 58-63);  
and

sending of the video instant message to the recipient after generation of the video instant message is completed (col. 5, lines 25-32, DeSimone discloses an instant message being sent from a sender to multiple recipients).

DeSimone fails to teach the limitation further including storing the video instant message at the instant messaging host and providing, to the instant messaging host, an indication that triggers the sending of the message.

However, Ozkan teaches a method and system for conveying video messages (see abstract). Ozkan teaches a communication manager storing video data received (col. 13, lines 40-45) and videos being sent when the capture process has stopped (col. 13, lines 9-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Ozkan to store the video instant message at the instant messaging host and use a trigger to send the video after it is completed. One would be motivated to do so because it allows for the completed video to be automatically sent without extra, unnecessary steps from the user.

Regarding claims 37, 49, 57, and 65, DeSimone teaches the method and computer program of claims 36, 48, 56, and 64 wherein storing the video instant message comprises storing the video instant message in a location that is immutable by the sender (col. 4, lines 46-56, col. 5, lines 25-32).

Regarding claims 38, 50, 58, and 66, DeSimone teaches the method and computer program of claims 36, 48, 56, and 64 further comprising generating, during the instant messaging communications session between the sender and the recipient, a text instant message to the recipient on behalf of the sender and providing, to the instant messaging host, the text instant message to the recipient (col. 4, lines 46-56, col. 5, lines 25-32).

Regarding claims 43, 51, 63, and 67, DeSimone teaches the method and computer program of claims 36, 48, 56, and 64 further comprising providing, to the instant messaging host, a request to establish video communication (col. 5, lines 46-48,

col. 15, lines 58-63, DeSimone discloses conversations initiated by the sender and video messages).

As to claims 48, 64, and 69, DeSimone teaches a communications method, comprising:

establishing an instant messaging communications session between a sender and a recipient through an instant messaging host (col. 1, lines 25-33, col. 4, lines 24-29); and

during the instant messaging communications session between the sender and the recipient:

receiving a video instant message from the instant messaging host on behalf of the recipient (col. 1, lines 25-33, col. 4, lines 24-29, col. 5, lines 25-32);

storing the video instant message (col. 1, lines 45-47, col. 15, lines 58-63);

accessing the video instant message (col. 4, lines 46-56, DeSimone discloses messages sent to a server); and

presenting the video instant message to the recipient (col. 4, lines 46-56, col. 5, lines 25-32).

DeSimone fails to teach the limitation further including receiving the message after the instant messaging host receives an indication that generation of the video instant message is completed and storing and accessing the video instant message at the instant messaging host.

However, Ozkan teaches videos being sent when the capture process has stopped (col. 13, lines 9-35) and a communication manager storing video data received (col. 13, lines 40-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Ozkan to use a trigger to send the video after it is completed and storing and accessing the video instant message at the instant messaging host. One would be motivated to do so because it allows for the completed video to be automatically sent without extra, unnecessary steps from the user.

Regarding claims 70, 72, 74, and 76, Ozkan teaches the method and system of claims 36, 48, 68, and 69, wherein generating the video instant message with a client device comprising a processor, a controller and a storage medium (col. 10, lines 30-47, Ozkan discloses a video capture device).

Regarding claims 71, 73, 75, and 77, Ozkan teaches the method and system of claims 70, 72, 74, and 76, wherein the client device comprises a set-top box (col. 10, lines 30-47, Ozkan discloses a visual and audio sensor system).

3. Claims 39-42 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Ozkan further in view of Doty, Jr., U.S. Patent No. 6,795,863.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract). Ozkan teaches the invention substantially as claimed including a method and system for conveying video messages (see abstract).

As to claims 39-42 and 59-62, DeSimone and Ozkan teach the method and computer program of claims 36 and 56.

DeSimone and Ozkan fail to teach the limitation further including accessing an indication of capabilities of the recipient, identifying hardware and software associated with the recipient, and displaying a user interface according to the capabilities of the recipient.

However, Doty, Jr. teaches a plurality of client recipient computers, wherein the video streams may be embedded into a web page that provides e-mail services, preferably over the Internet (see abstract). Doty, Jr. teaches the use of a recipient computer specifying its hardware and software capabilities (col. 8, lines 45-50) and a product distribution smart server basing its data stream format on recipient capabilities (col. 8, lines 54-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone and Ozkan in view of Doty, Jr. to access an indication of capabilities of the recipient, identify hardware and software associated with the



recipient, and displaying a user interface according to the capabilities of the recipient. One would be motivated to do so because it would allow for the recipient to view the video communication at the best possible quality and to avoid errors in viewing.

4. Claims 44-47 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Ozkan further in view of Wan et al., U.S. Patent No. 6,529,475.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract). Ozkan teaches the invention substantially as claimed including a method and system for conveying video messages (see abstract).

As to claims 44-47 and 52-55, DeSimone and Ozkan teach the method of claims 36 and 48.

DeSimone and Ozkan fail to teach the limitation further including the video communication comprising establishing a generic signaling interface channel, a control channel, and a video channel between the sender and the recipient, the control channel comprising a TCP/IP socket, the video channel comprising a UDP channel, and the video channel comprising a TCP channel.

However, Wan teaches a method and system for improving flow of data traffic within a multimedia communications network by reducing congestion (see abstract).

Wan teaches the use of a signaling channel, control channel, and data channel through which video is sent and TCP for the video and control channel (col. 3, lines 24-30) and UDP for the video (col. 3, lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone and Ozkan in view of Wan to use a generic signaling interface channel, a control channel, and a video channel between the sender and the recipient, the control channel comprising a TCP/IP socket, the video channel comprising a UDP channel, and the video channel comprising a TCP channel. One would be motivated to do so because a UDP channel minimizes latency and a TCP channel is used to pass through firewalls that block UDP.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 36, 48, 56, 64, 68, and 69 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed April 17, 2006 have been fully considered but they are not persuasive.

Regarding the argument to claims 36, 48, 56, 64, 68, and 69, the applicant argues that the reference, Ozkan, does not disclose providing an indication, which is sent to an instant messaging host, that triggers the sending of a video instant message. The examiner respectfully disagrees, as seen in, col. 13, lines 9-35, there is a capture process that once it is stopped, videos are sent. The capture process being stopped is the indication that triggers the sending.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,748,421 to Ozkan et al.

U.S. Pat. No. 6,677,976 to Parker et al.

U.S. Pat. No. 6,564,248 to Budge et al.

U.S. Pat. No. 5,956,716 to Kenner et al.

U.S. Pat. No. 5,793,365 to Tang et al.

U.S. Pat. No. 5,764,916 to Busey et al.

U.S. Pat. No. 6,738,822 to Fukasawa et al.

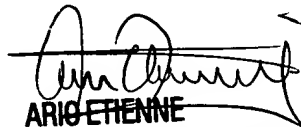
Any inquiry concerning this communication or earlier communications from the examiner should be directed to [redacted] whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold  
Patent Examiner  
Art Unit 2157

AMG

  
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